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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,281

11/14/2003

James Castleman

109.0037

2030

27997 7590 09/21/2009

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EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

09/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/714,281	Applicant(s) CASTLEMAN ET AL.	
	Examiner VALERIE LUBIN	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Claims 5-24 are pending

For reference purposes, the document paper number is 20090910

Response to Arguments

2. Applicant's arguments with respect to claims 5-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 5-18 and 20-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Independent claim 5 is directed to a system which comprises a risk data repository, and insurance data repository and a risk evaluator. The repositories constitute data and the risk evaluator is a software module. Hence, claim 5 is directed to non-patent eligible statutory matter.

Claims 6-13 and 22-24, as dependents of claim 5, are also rejected under the above analysis.

6. Claims 14-18 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to a particular apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg U.S. Patent No. 6,456,979 in view of Libman U.S. Patent No. 6,999,938, further in view of Debber Pre-Grant Pub. No. 2003/0144887.

9. For claim 5, Flagg discloses a system comprising: an insurance data repository including information about available insurance components (Fig. 12 element 250); and determining risks and costs associated with providing insurance and computing overall risk and cost for an insurance product and adjust parameters of the package components including adjusting the cost of an insurance product in light of the effect on said risk of the at least additional component to optimize the risk and cost of the insurance product (Abstract, Fig. 2 element 90).

Flagg recites a matrix of risk values (Abstract). He does not specifically recite a risk data repository for storing risk information to be used in determining the risk and cost of providing insurance packages and a risk evaluator; however Debber does (§ 73). It would have been obvious to one of ordinary skill in the art to combine the teachings of Flagg and Debber to have a risk data repository and to perform Flagg's method using computer software in order to readily access necessary risk data from such database and perform calculations of different computing devices.

Flagg and Debber do not disclose the insurance data repository including information about a mortgage insurance component and additional insurance components; however,

Libman does (Fig. 9, col. 14 lines 23-27). It would have been obvious to one of ordinary skill in the art to combine the teachings of Flagg, Debber and Libman to include data about mortgage insurance and insurance packages in order to market bundled products to customers with more than one type of insurance need.

Claims 14 and 19 are rejected under the analysis of claim 5, as they recite the method performed by the above system.

10. For claim 6, Libman discloses a package terms development module and insurance packages (Col. 20 lines 45-67; col. 21 lines 55-58; col. 14 lines 23-27). It would have been obvious to one of ordinary skill in the art to combine the teachings of Debber and Libman to allow for terms development based on different criteria in order to develop and market packages that are suitable to potential customers.

Claims 15-17 and claim 24 are rejected under the analysis of claim 6.

11. Claim 7 is rejected, as Debber recites an operator interface module (§ 66).

Claim 8 is rejected under the analysis of claim 7.

12. For claim 9, Debber and Libman do not recite a package negotiation module; however, Examiner takes Official Notice that means for negotiating/accepting or committing to insurance products were old and well known in the art at the time the invention was made. It would therefore have been obvious to one of ordinary skill in the art to combine the prior art to include a means by which a consumer can negotiate a product in order for providers to be more competitive.

13. With respect to claim 10, Libman recites insurance packages (Col. 14. lines 23-27). A predictable result of Debber and Libman would be to provide as many types of insurance packages as possible to clients in order to offer them better more customized products to meet their needs at competitive prices (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)). Furthermore, the type of insurance package is non-functional descriptive material that does not further limit the system of claim 5 (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

Claims 11 and 20 rejected under the analysis of claim 10.

14. Claim 12 is rejected, as Debber recites a data processing system (Abstract).

15. Claim 13 is rejected, as Debber recites the Internet (Abstract).

16. For claim 18, Debber discloses presenting a hypertext form and receiving a submission of information entered using the hypertext forms (§ 92, 93, 96).

17. With regards, to claim 21, Flagg, Debber and Libman do not specifically recite discounting the computed cost by taking into account a reduced likelihood of default on the mortgage due to the job loss component. However, Examiner takes Official Notice that reducing policy costs based on certain parameters or clients' potential circumstances was old and well known in the art at the time the invention was made. It would therefore have been

obvious to one of ordinary skill in the art to combine the prior art in order to see the impact of such parameters on costs and to accurately derive such costs.

Claim 22 is also rejected under the above analysis.

18. With regards to claim 23, Debber discloses an experience modifier module 412 which modifies insurance product data based on factors such as salary, job type, and historical loss for example. It would have been obvious to one of ordinary skill in the art to combine the teachings of Flagg, Debber and Libman to include performance of a sensitivity analysis on the different parameters involved in illustrating an insurance product or package, in order to present different scenarios to customers that will help them choose the product that best meets their financial situations.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Luchs et al., U.S. Patent No. 4,831,526 discloses means for negotiating an insurance product as well as other of Applicant's limitations.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. L./

Examiner, Art Unit 3626

/C. Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626